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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,484	12/11/2001	Achim Franck	tesa AG 1510-WCG	1006

27386 7590 10/31/2003

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EXAMINER
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ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

206

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 3-13, 15-18 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

Application Papers

- ☒ The proposed drawing correction, filed on 3/8/02 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit 1771

1. The proposed correction to Figure 1 and Figure 2 has been noted and is approved. It is further noted that in the specification, "Example B" there is a reference to "Figure 2a" which does not appear to be in the application papers.

Clarification is requested.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, the terms "Average roughness  $R_a$ " and "Average depth of roughness  $R_z$ " are present in both of applicants' Examples, but nowhere are these terms defined, with the possible exception of a reference to DIN 4768. Additionally, in Example B, as previously mentioned above, there is a reference to Figure 2a, but this Figure is not found in the application at the present time.

Art Unit 1771

4. The use of the trademarks set forth at page 8, fourth paragraph of the specification and comprising applicants' adhesive composition used in their Examples has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

6. Claims 1, 3-13 and 15-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, despite the recent claim amendments quite a few problems still remain. In claim 1 there is no structure whatsoever with respect to the "surface" that is bonded to the double sided adhesive sheet, and it is suggested that applicants incorporate some structure of the "self-adhesive device" into the "comprising" section of the claim (it is suggested to utilize --comprising-- instead of "having"). Additionally, in the next to last line of

Art Unit 1771

claim 1 it would appear that "grip tab" is singular, but in lines 3 and 4 of the claim it would appear that more than one may be present. In claim 5, line 1, "area" lacks antecedent basis and the last line of the claim <sup>1</sup>needs both Markush language and the phrase "or is produced in a subsequent step" is vague, indefinite and confusing. In claim 7 it is not clear as to what "areas" are being referred to since the "two opposite edges of said surface" is unclear as to whether or not the various widths or the ends of the "surface" are being referred to. In claim 9, "low" in lines 2 and 3 is unduly vague and indefinite. In claim 10, line 2 the phrase "without a carrier in between" is vague and indefinite with respect to the structure being referred to. In claim 11, line 4, the words "high" and "low" <sup>(also claim 17)</sup> are similarly again considered to be vague and indefinite. In claim 13, line 2, the phrase "or the like" is considered informal, and the phrase "front face" lacks antecedent basis.

7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit 1771

8. Claims 1, 3-13, and 15-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lühmann et al. -397 (EP 0832588A2 is cumulative). The reference discloses (note particularly the Abstract, Figures 1, 2 and 4, column 1 lines 6-9, line 61 - column 2 line 5, column 2 lines 43-55, column 3 lines 16-18, lines 23-48, lines 57-62, column 4 lines 11-27, lines 35-41, line 66 - column 5 line 4, column 5 lines 29-34, column 6 lines 23-32, column 7 lines 1-12, the Examples) ~~discloses~~ substantially an anticipation of at least applicants' broad claim, as well as several of the dependent claims, except for the notable absence of what appears to be the point of novelty, the range of Average roughness  $R_a$  ~~and~~ with respect to the frictional characteristic of the sections 3A and 3B and the adjacent area of the disclosed self-adhesive device. However, the reference clearly teaches (e.g. the Abstract, column 2 lines 53-54, column 4 lines 12-17) the desirability of having low coefficients of slip friction and stick friction in the aforementioned areas to improve the bonding redetachability characteristics of the article, which is essentially what is believed applicants' roughness parameters measure. Note that the reference teaches (column 5, lines 29-34) how to adjust the frictional coefficients so as to obtain the desired frictional, i.e. roughness characteristics required for the claimed article. As such, the Examiner believes that the claimed range of Average

Art Unit 1771

roughness  $R_a$  values would be at most an obvious optimization to one of ordinary skill. Alternatively, Lühmann et al. -949 or -665, each cited as evidence of the state of the art, disclose (note particularly Lühmann et al. -949, column 1 lines 34-48; Lühmann et al. -665, column 1 lines 36-46, column 7 lines 10-50) ~~each disclose~~ redetachable adhesive tapes taken from essentially the identical art as the primary reference, and further disclose the relationship between rough or smooth surfaces and their resulting adhesive bond area strength. Accordingly, one of ordinary skill, would have more than ample motivation to configure the regions that are substantially adjacent to <sup>the</sup> grip tab of applicants' adhesive sheet with a desired amount of roughness and thereby clearly form the same claimed genus of articles. Other parameters that are not either expressly or inherently disclosed, such as the product-by-process limitations of claim 5, the adhesive composition of claim 11, or the presence of release sheets such as set forth in claim 12 are each believed to be, if not either expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner

Serial No. 10/014,484

-7-

Art Unit 1771

can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 29, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zinker*